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OFFICE OF PETITIONS

In re Application of

Christopher

Application No. 08/746,360

Filing Date: November 8, 1996

For: FINITE AMPLITUDE DISTORTION-  
BASED INHOMOGENEOUS PULSE ECHO  
ULTRASONIC IMAGING

: Decision on Petition for  
: Patent Term Adjustment

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term adjustment entitled "Petition For Patent Term Adjustment Under 37 CFR 1.705," received on September 19, 2005. In the alternative, the petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701 and 37 CFR 1.181. See 35 U.S.C. § 154(b)<sup>1</sup> and 37 CFR § 1.701.

The petition under 37 CFR 1.705 is dismissed.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that the Notice of Allowance mailed on June 15, 2005, for the above-identified application did not contain an indication of patent term extension under 35 U.S.C. §154(b).

Petitioner contends that in accordance with 35 U.S.C. 154(b) as amended by the URAA and 37 CFR 1.701 the instant application is entitled to Patent Term Extension as compensation for the delay due to public use proceeding. Petitioner asserts that the public use proceedings are the equivalent of an interference in structure, conduct, intent and effect, therefore the application should be eligible for 1,117 days of patent term extension under the prior provisions of 35 U.S.C. 154(b).

Petitioner contends that in accordance with 35 U.S.C. 154(b) as amended by the PTGA and 37 CFR 1.705 the instant application is entitled to Patent Term Adjustment as compensation for the delay due to public use proceeding. Petitioner asserts that the public use proceedings are the equivalent of an interference in structure, conduct, intent and effect, therefore the application should be eligible for

<sup>1</sup>35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

2,241 days of patent term adjustment under the current provisions of 35 U.S.C. 154(b). Petitioner asserts that applications that were filed before but still pending on May 29, 2000 are eligible for patent term adjustment.

35 U.S.C. § 154(b)(as amended by the “Uruguay Round Agreements Act,” enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the “American Inventors Protection Act of 1999,” enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000.

The above-identified application was filed on November 8, 1996. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

With respect to Petitioner’s argument that patent term extension should be awarded to the above-identified application because a public use proceeding is analogous to an interference, both 35 U.S.C. 154(b) and 37 CFR 1.701(c)(1) require an interference proceeding under 35 U.S.C. 135(a) to be eligible for patent term extension. Public use proceedings are not listed as one of the enumerated statutory grounds for patent term extension in the statute.

With respect to petitioner’s assertion that the application is alternatively entitled to patent term adjustment under 35 U.S.C. 154(b) as amended by the AIPA, the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Petitioner’s argument that the statutory language “[S]hall apply to any application filed on or after the date that is 6 months after the date of the enactment of this Act” means that the provision also applies to applications filed prior to the date of enactment and still pending is not persuasive. Petitioner’s interpretation of the statute is contrary to the plain meaning of the statute.

With respect to Petitioner’s contention that it is not fair to deny the instant application a patent term extension or a patent term adjustment due to the delays in prosecution, the delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b). It is noted that Congress did not make the more generous patent term adjustment provisions in current 35 U.S.C. 154 retroactively available to the instant application. Since Congress failed to make the provisions applicable in the instant application, the Office cannot either.

After mailing of this decision, the above-identified application will be forwarded to the Office of Publications.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized the required \$200 fee for the petition under 37 CFR 1.705(b) has been charged to Petitioner’s Deposit

Account (19-3886/RCT). The petition fee under 37 CFR 1.182 for "questions not specifically provided for" has not been charged to Petitioner's deposit account.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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